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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,325	08/10/2001	Martin Gleave	UBC.P-020	8469
21121	7590	01/14/2004	EXAMINER	
OPPEDAHL AND LARSON LLP			LACOURCIERE, KAREN A	
P O BOX 5068			ART UNIT	
DILLON, CO 80435-5068			PAPER NUMBER	
			1635	

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/913,325	GLEAVE ET AL.	
	Examiner	Art Unit	
	Karen A. Lacourciere	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 October 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-34 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

6)  Other: \_\_\_\_\_.

#### **DETAILED ACTION**

The restriction set forth in the prior office action, mailed 10-03-2003, is hereby withdrawn and a new restriction is set forth herein. This new restriction is set forth to address claims 24-34, which were not included as part of the original restriction because of improper indexing in the electronic file. The Examiner apologizes for any inconvenience to Applicant.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 6-9, 12-17, 24, 25, 26, 29 and 30, drawn to a method of delaying progression of prostatic tumor cells to an androgen-independent state using an antisense of SEQ ID NO:4.

Group II, claim(s) 1, 2, 4, 6-8, 10, 12-17, 24, 25, 27, 31 and 32, drawn to a method of delaying progression of prostatic tumor cells to an androgen-independent state using an antisense of SEQ ID NO:5.

Group III, claim(s) 1, 2, 5, 6-8, 11, 12-17, 24, 25, 28, 33 and 34, drawn to a method of delaying progression of prostatic tumor cells to an androgen-independent state using an antisense of SEQ ID NO:12.

Group IV, claim(s) 18-23, drawn to a method of enhancing the chemo- or radiation sensitivity of cancer cells using SEQ ID NO:4.

Group V, claim(s) 18-23, drawn to a method of enhancing the chemo- or radiation sensitivity of cancer cells using SEQ ID NO:5.

Group VI, claim(s) 18-23, drawn to a method of enhancing the chemo- or radiation sensitivity of cancer cells using SEQ ID NO:12.

The inventions listed as Groups I and II and III and IV and V and VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

This international searching authority considers that the international application does not comply with the requirements of unity of invention (Rules 13.1, 13.2, and 13.3) for the reasons indicated below:

According to the guidelines in Section (f)(i)(a) of Annex B of the PCT Administrative Instructions, the special technical feature as defined by PCT Rule 13.2 shall be considered to be met when all the alternatives of a Markush-group are of similar nature. For chemical alternatives, such as the claimed antisense sequences, the Markush group shall be regarded as being of similar nature when

- (A) all alternatives have a common property or activity and
- (B)(1) a common structure is present, i.e., a significant structure is shared by all of the alternatives or
- (B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to an art recognized class of compounds in the art to which the invention pertains.

The inventions of each of Groups I and II and III lack unity of invention because each of the inventions utilizes a different antisense sequence, namely SEQ ID NO:4, 5 and 12.

The inventions of each of Groups IV and V and VI lack unity of invention because each of the inventions utilizes a different antisense sequence, namely SEQ ID NO:4, 5 and 12.

The instant antisense sequences, SEQ ID NO: 4 and 5 ad 12 are considered to be each separate inventions for the following reasons:

The sequences do not meet the criteria of (A), common property or activity or (B)(2), art recognized class of compounds. Although the sequence target and modulate

expression of the same gene, each antisense sequence behaves in a different way in the context of the claimed invention. Each sequence targets a different and specific region of TRPM-2 and each sequence modifies the expression of the gene to a varying degree. Each member of the class cannot be substituted, one for the other, with the expectation that the same intended result would be achieved.

Further, although the sequence target the same gene, the sequences do not meet the criteria of (B)(1), as they do not share, one with another, a common core structure. Accordingly, unity of invention between the antisense sequences is lacking and each antisense sequence claimed is considered to constitute a special technical feature.

The inventions of each of Groups I and II and II lack unity of invention with each of the invention of Groups IV and V and VI because they lack a common corresponding technical feature, for example, the technical feature of Groups I and II and III of delaying progression of prostatic tumor cells to an androgen independent state is not a feature of any of the methods of Groups IV and V and VI. Further, the technical feature of inducing increased chemo- or radiation sensitivity of Groups IV and V and VI is not present in any of the methods of Group I or II or III.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant was contacted by telephone to confirm that the election filed 10-30-2003 would be maintained in this modified restriction, however, no confirmation could be obtained, so a new written restriction has been prepared. If applicant would like to confirm the election by telephone, please contact the examiner at the number listed below.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (703) 308-7523. The examiner can normally be reached on Monday-Thursday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (703) 308-0447. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere  
September 30, 2003

*Karen Lacourciere*  
KAREN A. LACOURCIERE, PH.D  
PRIMARY EXAMINER